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EXAMINER

ZIA, SYED

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/489,328

Applicant(s)

MIETTINEN ET AL.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on January 26, 2004 (Paper No. 5). Original application contained Claims 1-26. Applicant amended Claims 1, 3, 10, 17-19, and 22. The amendment filed on January 26, 2004 (Paper No. 5) have been entered and made of record. Therefore, presently pending claims are 1-26.

### ***Drawings***

1. The drawings were received on January 26, 2004 (Paper No. 5). These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

2. Rejection of claims 3, 4, and 19, under 35 U.S.C. § 112, second paragraph is now withdrawn.

### ***Response to Arguments***

Applicant's arguments filed January 26, 2004 (Paper No. 5) have been fully considered but they are not persuasive because of the following reasons:

Applicants argued that cited prior art (CPA) [Bisbee U.S. Patent No. 6,367,013] does not teach and fails to disclose “*issuing an electronic identity for identifying an entity*” and “*issuing a second identity for an entity based on a first electronic identity of the entity*”.

This is not found persuasive. The system of CPA clearly teaches and describes a system and method where the stored electronic-original information are selected and re-validated by verifying the digital signature of a trusted custodial utility, which is applied to the selected electronic-original information. A current date, time stamp, digital signature and current authentication certificate of the trusted custodial utility are provided to the re-validated electronic-original information. This system also provides evidence and security for transfer and retrieval of electronic-original information through e-mail, facsimile, imaging, electronic data interchange or electronic fund transfer. Thus, the authentication certificate of trusted custodial utility are provided to the document before the expiration of the validity period of the previous authentication certificate, the validity period of the document is reliably extended and the transfer agent can effectively sign an information object by appending verifiable digitized signature and content integrity block.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that the system of CPA does teach or suggest the subject matter broadly recited in independent Claim 1, and dependent Claims 2-26. Accordingly, rejections for Claims 1-26 are respectfully maintained.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bisbee et al. U.S. Patent No. 6,367,013 ('Bisbee' hereinafter).

5. With respect to claim 1, Bisbee discloses a method for issuing an electronic identity for an entity from an identity registration authority (see abstract), the method comprising the steps of: a) issuing a first electronic identity for said entity (see Fig. 1, Col. 6, lines 39-41 b) creating a request for a second electronic identity for said entity, the request including an identifier of said entity (see Col. 5, lines 6-14); c) sending said request to said identity registration authority (see Col. 11, lines 20-32; Fig. 2); d) in response to said request, creating an identification response (see Col. 3, lines 55-65; Col. 4, lines 49-65); e) sending said identification response to said entity (see Col. 4, lines 49-67 to Col. 5, lines 1-5);  
f) verifying an acceptability of said identification response by said entity (see col. 5, lines 36-41);

g) in response to said verifying, if said identification response is acceptable, signing digitally said identification response by said first entity (see col. 8, lines 51-57; col. 13, lines 13-24);  
h) sending said signed response to said identity registration authority (see col. 8, lines 51-57);  
i) verifying a validity of said digital signature and said identification response in said signed response (see col. 5, lines 36-43; col. 13, lines 26-33, 48-51); and  
j) in response to said verifying, if said digital signature and identification response are valid, issuing a second identity based on said first identity (see col. 5, lines 6-35).

6. Claim 2 rejected as above in rejecting claim 1, further comprising a second entity by which said first entity digitally signs said identification response (see col. 5, lines 654).

7. Claim 3 rejected as above in rejecting claim 2, further comprising the steps of:  
checking if the information of said second entity is available using said identifier (see col. 5, lines 36-54); and  
in response said checking, if said information is not available, inquiring the information of said second entity from said first entity (see col. 5, lines 36-54).

8. Claim 4 rejected as above in rejecting claim 2, wherein said second entity is in control of said first entity (see col. 4, lines 33-67 to col. 5, lines 1-14).

9. Claim 5 rejected as above in rejecting claim 3, wherein said information of said second entity comprises one or more from the set containing a unique address of said second entity, the

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name of the holder of said second entity and previous identity or identities of said second entity (col. 5, lines 36-67 to col. 6, lines 1-21).

10. Claim 6 rejected as above in rejecting claim 1, further comprising the step of: establishing and encrypting a communication channel between said first entity and said identity registration authority to ensure confidential communication there between (Fig. 1; col. 6, lines 65-67 to col. 7, lines 1-2; col. 8, lines 9-20).

11. Claim 7 rejected as above in rejecting claim 1, further comprising the step of: storing said issued second identity to the database of said identity registration authority (col. 3, lines 55-65-1 col. 4, lines 33-48; col. 5, lines 15-35).

12. Claim 8 rejected as above in rejecting claim 1, further comprising the step of: storing said issued second identity to the database of the issuer of said first electronic identity (col. 3, lines 55-65; col. 4, lines 33-48; col. 5, lines 15-35).

13. Claim 9 rejected as above in rejecting claim 1, further comprising the step of combining said first and said second electronic identities to form a combined electronic identity (see col. 8, lines 57-61; col. 9, lines 27-32); and storing said combined electronic identity to the database (see col. 11, lines 2032, Fig. 2; col. 16, lines 47-55).

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14. Claim 10 rejected as above in rejecting claim 1, further comprising the step of: sending said issued second identity to said first entity (see col. 5, lines 6-14).

15. Claim 11 rejected as above in rejecting claim 1 further comprising the step of: sending said issued second identity to a third party (see col. 5, lines 36-41).

16. Claim 12 rejected as above in rejecting claim 1, before the step of issuing said second identity further comprising the steps of: checking if additional guarantees for ensuring a validity of the first identity are to be acquired (see col. 4, lines 33-48), and in response to said checking, if additional guarantees are needed, acquiring additional guarantees (see col. 3, lines 55-62; col. 4, lines 33-57).

17. Claim 13 rejected as above in rejecting claim 1, further comprising the steps of: adding a time stamp to said issued second identity (see col. 4, lines 33-48); and storing said time stamped second identity to the database of said registration authority (see col. 4, lines 33-48; col. 5, lines 6-35).

18. Claim 14 rejected as above in rejecting claim 1, further comprising the step of: adding into said time stamp a expiration date of said second electronic identity (col. 5, lines 36-54).

19. Claim 15 rejected as above in rejecting claim 1, further comprising the steps of: adding a notarization to said issued second identity (see col. 5, lines 55-67 to col. 6, lines 1-20); and



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storing said notarized second identity to the database of said registration authority (see col. 3, lines 55-65; col. 4, lines 33-48; col. 5, lines 15-35).

20. Claim 16 rejected as above in rejecting claim 1, further comprising the steps of: inquiring a further identifier code to be added into said signed identification response (see col. 5, lines 36-54; col. 14, lines 44-60); receiving said identifier code at said registration authority (see col. 5, lines 36-54; col. 7, lines 35-40; col. 14, lines 44-60); and verifying the validity of said identifier code at said registration authority (see col. 5, lines 36-54; col. 7, lines 35-40).

21. Claim 17 rejected as above in rejecting claim 16, wherein said identifier code includes one or more from the set containing biometric code of said first entity, a predetermined character string, a fingerprint of the first entity's public key, random number, certificate, and a hash code of the shared secret between said first entity and said registration authority (see col. 7, lines 55-65; col. 8, lines 51-67 to col. 9, lines 1-5-1 col. 9, lines 65-67 to col. 10, lines 1-17).

22. Claim 18 rejected as above in rejecting claim 2, further comprising the steps of: creating a first hash code from said identity request at registration authority (see col. 9, lines 1-5, 44-64; col. 10, lines 10-17); sending said first hash code to said second entity (see col. 2, lines 38-45; col. 9, lines 44-64); creating a second hash code from said identity request by said second entity (see col. 2, lines 38-45); and verifying a validity of said first hash code by comparing it to said second has code before the signing of said response (see col. 9, lines 44-64).

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23. Claim 19 rejected as above in rejecting claim 1, before the step of issuing further comprising the steps of: sending a confirmation message to the address specified in said additional information of said first entity (see col. 17, lines 33-67 to col. 18, lines 1-14); receiving a confirmation response to said confirmation message at said registration authority (see col. 17, lines 33-67 to col. 18, lines 1-14); and verifying the validity of said confirmation response (see col. 17, lines 33-67 to col. 18, lines 1-14).

24. Claim 20 rejected as above in rejecting claim 19, before the step of issuing further comprising the step of: canceling said issuing of said second electronic identity if said confirmation response is not received in a predetermined time period (see col. 25, lines 48-53).

25. Claim 21 rejected as above in rejecting claim 1, wherein said request for issuing said second certification for said entity is initiated by said third party (see col. 3, lines 36-41; col. 23, lines 39-44).

26. Claim 22 rejected as above in rejecting claim 2, wherein said request for issuing said second certificate for said entity is initiated by said second entity (see col. 5, lines 6-35).

27. Claim 23 rejected as above in rejecting claim 2, wherein said request is digitally signed by said first entity before sending said request (see col. 5, lines 6-54).

28. Claim 24 rejected as above in rejecting claim 2, wherein said request is encrypted before sending said request (see col. 8, lines 9-14, 40-50).

29. Claim 25 rejected as above in rejecting claim 1, further comprising the step of:  
journalizing a log of all transaction during the issue process of said second electronic identity (see col. 3, lines 46-65).

30. Claim 26 rejected as above in rejecting claim 2, wherein said second entity is one of the following set including mobile terminal, mobile phone, personal computer, set-top box, smart card, tamper proof device, security token, software agent, pager, terminal equipment, and personal digital assistant (PDA) (see col. 7, lines 6-25; col. 8, lines 2239).

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ  
March 27, 2004

  
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